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10/825,960	04/16/2004	Steven L. VanFleet	020375-050200US	8212

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EXAMINER

CHUNG, JULIUS J

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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,960	Applicant(s) VANFLEET ET AL.	
	Examiner JULIUS J. CHUNG	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to communication received 4/23/2008.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4-5, 8, 19, and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715), as set forth in previous office action, and further in view of Wieffering et al. (Eric Wieffering, Melissa Levy, Staff Writers. "Red-hot Target Visa draws scrutiny". Star tribune. Minneapolis, Minn.: Apr 6, 2003. pg. 1.D).**

As to claim 1, Chen et al. teaches: A computerized method comprising: receiving (**"The authorization ticket is then forwarded to the account servicer, at which point the account servicer uses the private key associated with the selected public key in order to decrypt the file and verify the status of the account," col.6 lines 51-54**), at a payment network, a first information packet from a merchant, the first information packet including a

cost of a financial transaction between the merchant and a customer (**“When the merchant receives the authorization ticket, the merchant then embeds or associates it with whatever information the merchant needs to provide the account servicer,” col.6 lines 48-50**) and a card account identifier (**“The customer then makes an order and the merchant requests an authorization ticket in the form of payment or account information encrypted by one of the public keys in the public key file,” col.6 lines 33-36**) presented by the customer as a payment for the financial transaction; using the card account identifier to determine, with the payment network, account information that identifies a financial account maintained by the customer at a financial institution and authorization information that allows debit access to the identified financial account (**“... including ... account information, a user PIN number, a user ID, MAC, and any other information which might be needed during the payment and authentication process. This information is associated with a public key file preferably containing a plurality of public keys associated with a single root key, and key identifiers. The entire wallet is then provided to the customer, in any form which enables the customer to utilize the wallet, for example as a software package for use on the customer's portable computer, or on a smart card which can be carried around by the customer and used at kiosks provided with smart card readers,” col.6 lines 12-21**); generating, at the payment network, a request to perform a debit transaction from the identified financial account for the cost of the financial transaction (**“In addition, it will be appreciated by those skilled in the art that**

the cyber wallet can be used for a variety of transactions, including both credit and debit type transactions, although for convenience the term "credit" will be used to describe all such transactions," col. 1 lines 17-21 and "If the transaction is approved, the account servicer then sends an approval message back to the merchant, together with decrypted information necessary for the merchant's records," col. 6 lines 54-57).

What Chen et al. fails to teach is: A private label card account identifier presented by the customer as a payment for the financial transaction being a form of payment accepted only by one of the merchant and a merchant consortium that includes the merchant; using the private label card account identifier; and generating, at the payment network, a second information packet comprising the transaction information, the account information, and the authorization information; and transmitting from the payment network, the second information packet to the financial institution with a request to perform a debit transaction from the identified financial account for the cost of the financial transaction and a private label card being one issued by one of a merchant and merchant consortium that includes the merchant separate from the financial institution who are the only ones to accept such payment.

Pinizzotto teaches: A private label card (**"It should be understood that the purchase card can be a credit card, private label card, debit card, gift card or any other card or device which provides the purchaser account identification," page 4 paragraph 58**) account identifier presented by the customer as a payment for the financial transaction being a form of payment

accepted only by one of the merchant and a merchant consortium that includes the merchant using the private label card account identifier (**"The computer then sends out the ordering information on the Internet as indicated at Fig.2 item 26; which ordering information includes the encrypted purchaser account information data (PAID) and encrypted purchaser personal identification data (PPID). This ordering information is received at the processing center's processor," page 2 paragraph 33)**; and generating, at the payment network, a second information packet comprising the transaction information, the account information, and the authorization information; and transmitting from the payment network, the second information packet to the financial institution with a request to perform a debit transaction from the identified financial account for the cost of the financial transaction (**"The processor at the center, as indicated at Fig 2 item 31, makes an appropriate inquiry of a bank or credit processing station concerning the availability of the funds in the bank for a debit card or check or the credit available for a credit card. The processor then receives confirmation from the bank or the credit station," page 2 paragraph 34)**).

It would have thus been obvious to one of ordinary skill in the art at the time the invention was made to combine the private label card and separate processing center as disclosed in Pinizzotto to the computerized method for debit transactions in Chen et al. to achieve the claimed invention. The motivation for the combination would be to improve the security of customer information for a

wide variety of accounts by organizing the purchase account at a central processing center.

Wieffering et al. teaches: a private label card being one issued by one of a merchant and merchant consortium that includes the merchant separate from the financial institution who are the only ones to accept such payment **(see at least page 2 para 3-4).**

It would have thus been obvious to one of ordinary skill in the art at the time the invention was made to set the cyber wallet in Chen et al. to only be accepted and issued by a merchant as in Wieffereing et al. to improve customer loyalty.

3. Claims 2-3, 6, and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) and Pinizzotto (US 2003/0191715) and Wieffering et al. (Eric Wieffering, Melissa Levy, Staff Writers. "Red-hot Target Visa draws scrutiny". Star tribune. Minneapolis, Minn.: Apr 6, 2003. pg. 1.D) and in further view of Goeller et al. (US 2002/0178112) as set forth in previous office action.

4. Claims 7 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) and Pinizzotto (US 2003/0191715) and Wieffering et al. (Eric Wieffering, Melissa Levy, Staff Writers. "Red-hot Target Visa draws scrutiny". Star tribune. Minneapolis,

Minn.: Apr 6, 2003. pg. 1.D) and in further view of Kazaks et al. (US 2002/0046341) as set forth in previous office action.

5. **Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) and Pinizzotto (US 2003/0191715) and Wieffering et al. (Eric Wieffering, Melissa Levy, Staff Writers. "Red-hot Target Visa draws scrutiny". Star tribune. Minneapolis, Minn.: Apr 6, 2003. pg. 1.D) and in further view of Brake, Jr. et al. (US 7,072,864) as set forth in previous office action.**

6. **10-11, 15, 27-28, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715) and further in view of Brake, Jr. et al. (US 7,072,864) as set forth in previous office action.**

As to claim 10, Chen et al. teaches: A computerized method comprising:
receiving, from a merchant, account information that identifies a financial account maintained by a customer at a financial institution and authorization information that allows debit access to the identified financial account (**"In addition, it will be appreciated by those skilled in the art that the cyber wallet can be used for a variety of transactions, including both credit and debit type transactions, although for convenience the term "credit" will be used to describe all such transactions,"** col. 1 lines 17-21 and **"First, the wallet is**

Comment [J1]: Examiners must articulate the following:
1)a finding that there was some teaching, suggestion, or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings,
2)a finding that there was reasonable expectation of success.

created by the account servicer or provider under secured conditions, by gathering together all information necessary to carry out credit transactions remotely over the Internet, including browser/mosaic software if necessary, account information, a user PIN number, a user ID, MAC, and any other information which might be needed during the payment and authentication process,” col.6 lines 12-21); verifying, through a payment network, the account information and authorization information (“The cyber wallet on which the preferred system and method is based is in the form of any account and/or personal information required to be transmitted to the account servicer in order to verify the account status,” col.4 lines 63-66); associating an account identifier for a card to the customer account information and authorization information (“This information is associated with a public key file preferably containing a plurality of public keys associated with a single root key, and key identifiers. The entire wallet is then provided to the customer, in any form which enables the customer to utilize the wallet, for example as a software package for use on the customer's portable computer, or on a smart card which can be carried around by the customer and used at kiosks provided with smart card readers,” col.6 lines 12-21 the servicer is separate from the merchant).

What Chen et al. fails to teach is: the private label card being a form of payment issued on behalf of one of the merchant and a merchant consortium that includes the merchant, the merchant and merchant consortium being

separate from the financial institution at which the financial account is maintained.

Pinizzotto teaches: the private label card being a form of payment issued on behalf of one of the merchant and a merchant consortium that includes the merchant, the merchant and merchant consortium being separate from the financial institution at which the financial account is maintained (**"It should be understood that the purchase card can be a credit card, private label card, debit card, gift card or any other card or device which provides the purchaser account identification,"** page 4 paragraph 58 this would also mean the merchant may be acting on behalf of the customer in terms of enrollment).

Brake, Jr. et al. teaches: transmitting, from the payment network, an enrollment approval for the customer to the merchant (**"If the credit bureau is up and running, the system performs the credit check. If the applicant is not approved for the credit card in Block (420), the customer account is transferred by the system and the customer will be offered the primary transaction card in FIG. 3D (510). If the customer is approved, the system is routed to Block (430) and automatically returns a credit line based upon the customer's credit check,"** col. 10 lines 14-21).

It would have thus been obvious to one of ordinary skill in the art to apply the private label card as disclosed in Pinizzotto and the enrollment approval as in Brake Jr. et al. to the purchase account creation in Chen et al. to achieve the claimed invention. The motivation for the combination would be to focus on

customer loyalty using an obvious variant of a debit card and improve disclosure (in this case of enrollment) to the customer.

7. Claims 12-14, 17, and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715) in view of Brake, Jr. et al. (US 7,072,864) and further in view of Smith et al. (US 5,777,305) as set forth in previous office action.

8. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715) in view of Brake, Jr. et al. (US 7,072,864) and further in view of Kazaks et al. (US 2002/0046341) as set forth in previous office action.

9. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715) in view of Brake, Jr. et al. (US 7,072,864) and further in view of Goeller et al. (US 2002/0178112) as set forth in previous office action.

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US 5,590,197) in view of Pinizzotto (US 2003/0191715) and in view of Brake, Jr. et al. (US 7,072,864) in view of Smith et al. (US 5,777,305) and further in view of Kazaks et al. (US 2002/0046341) as set

forth in previous office action.

Response to Arguments

1. Applicant's arguments filed 4/23/2008 have been fully considered but they are not persuasive.

Though the private label card is being addressed within the claimed invention, the card itself is not integrally linked to any of the disclosed method steps. Instead, the claim limitations are directed toward a "private label card account identifier". It is noted that this term may have very broad interpretations. In fact, anything that could identify the private label account would meet the metes and bounds of the claim.

Chen et al. discloses a digital wallet which uses a public key which is associated with account information and creates an authorization ticket. This account information could include any information necessary to carry out a credit transaction remotely over the internet. Since it may be any credit transaction, it may be a private label transaction and so the digital wallet may potentially identify the private label card account by the fact that a private label card may be treated the same as any credit transaction card.

Since there is no step in the method that utilizes the specific architecture of the private label card, the account identifier is merely acting as an alias to the given financial account much in the same way a digital wallet would behave. The addition of information making it clear that the private label card is issued by a

merchant or merchant consortium that is in fact separate from the financial institution further aggravates its likeness to the cyber wallet. Since the wallet will only be accepted by certain merchants, a consortium that may have the technology to add information to the authorization tickets.

Due to these reasons, the substantial elements are disclosed and because of the availability of this interpretation the combination would not teach away from the invention as claimed.

As to the named limitations, Chen et al. discloses: private label card account identifier (**"The customer then makes an order and the merchant requests an authorization ticket in the form of payment or account information encrypted by one of the public keys in the public key file," col.6 lines 33-36 which holds account information and can identify particular card accounts of interest**), using the card account identifier to determine, with the payment network, account information that identifies a financial account maintained by the customer at a financial institution and authorization information that allows debit access to the identified financial account (**"... including ... account information, a user PIN number, a user ID, MAC, and any other information which might be needed during the payment and authentication process. This information is associated with a public key file preferably containing a plurality of public keys associated with a single root key, and key identifiers. The entire wallet is then provided to the customer, in any form which enables the customer to utilize the wallet, for example as a software package for use on the customer's portable computer, or on a**

smart card which can be carried around by the customer and used at kiosks provided with smart card readers,” col.6 lines 12-21), and a request to perform a debit transaction from the identified financial account for the cost of the financial transaction (“In addition, it will be appreciated by those skilled in the art that the cyber wallet can be used for a variety of transactions, including both credit and debit type transactions, although for convenience the term "credit" will be used to describe all such transactions,” col. 1 lines 17-21 and “If the transaction is approved, the account servicer then sends an approval message back to the merchant, together with decrypted information necessary for the merchant's records,” col. 6 lines 54-57).

Pinizzotto et al. discloses: being a form of payment accepted only by one of the merchant and a merchant consortium that includes the merchant using the private label card account identifier (**“The computer then sends out the ordering information on the Internet as indicated at Fig.2 item 26; which ordering information includes the encrypted purchaser account information data (PAID) and encrypted purchaser personal identification data (PPID). This ordering information is received at the processing center's processor,”** page 2 paragraph 33 only a consortium of merchants that have the technology to interpret the data can utilize the system)

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JULIUS J. CHUNG whose telephone number is (571)270-1530. The examiner can normally be reached on 8:00 AM-6:30 PM Mon-Thu. Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571)272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art
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/Julius J Chung/
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July 14, 2008